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DEC 11 2009

Scott C Harris
P.O. Box 927649
San Diego, CA 92192

In re Application of: :
Scott C. Harris : DECISION ON PETITION
Application No. 10/065,120 : TO WITHDRAW THE
Filed: September 18, 2002 : HOLDING OF ABANDONMENT
For: POSITION PRIVACY IN :
ELECTRONIC DEVICE :
:

This is in response to appellant's petition, received September 26, 2009, requesting the withdrawal of the holding of abandonment dated June 11, 2009.

The petition is **DENIED**.

A review of the prosecution history reveals that an appeal brief was filed August 19, 2008. A Notification of Non-Compliant Appeal Brief was mailed August 28, 2008. Appellant submitted a corrected appeal brief on September 23, 2008. However, that appeal brief was also found to be defective, and a notice to that effect was mailed December 2, 2008. The second notice set forth a new extendible one month or 30-day time period in which to file a corrected brief. In response to the second notification of non-compliant appeal brief, appellant filed a second corrected appeal brief on January 1, 2009. However, the appeal brief is also defective, and a miscellaneous communication was mailed to the appellant on April 6, 2009. The miscellaneous communication indicates that the "time period for response continues to run from the mailing date of the last Notice of Defective Appeal Brief" (i.e., the Notice of Non-Compliant Appeal Brief mailed August 28, 2008. An appeal brief was filed April 9, 2009. A Communication Re: Appeal and a Notice of Abandonment were mailed June 11, 2009. The notice of communication regarding the appeal indicates that the "[t] Appeal Brief filed 4/6/09 is untimely and there are no extensions of time fees filed." It is noted that there is no appeal brief dated April 6, 2009; therefore, the examiner was referring to the April 9, 2009 appeal brief.

Relevant passages of MPEP and Regulations

37 CFR § 41.37 Appeal brief

...
(c)(1)(vii) Argument. The contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor,

with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown. Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

MPEP 1205.02 [R-3] Appeal Brief Content

Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. The failure of appellant to separately argue claims which appellant has grouped together constitutes a waiver of any argument that the Board must consider the patentability of any grouped claim separately. See *In re McDaniel*, 293 F.3d 1379, 1384, 63 USPQ2d 1462, 1465-66 (Fed. Cir. 2002). Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number.

For example, if Claims 1 to 5 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. Y and appellant is only going to argue the limitations of independent claim 1, and thereby group dependent claims 2 to 5 to stand or fall with independent claim 1, then one possible heading as required by this subsection could be "Rejection under 35 U.S.C. 102(b) over U.S. Patent No. Y" and the optional subheading would be "Claims 1 to 5." Another example is where claims 1 to 3 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. Z and appellant wishes to argue separately the patentability of each claim, a possible heading as required by this subsection could be "Rejection under 35 U.S.C. 102 (b) over U.S. Patent No. Z," and the optional subheadings would be "Claim 1," "Claim 2" and "Claim 3." Under each subheading the appellant would present the argument for patentability of that claim. The best practice is to use a subheading for each claim for which separate consideration by the Board is desired.<

1205.03 [R-3] Non-Compliant Appeal Brief and Amended Brief<

The question of whether a brief complies with the rule is a matter within the jurisdiction of the examiner ~~**>~~and the Board. The examiner will review the brief to ensure that the required items of the brief are present. Both the Board and the examiner will review the brief for compliance with the content requirements of the brief (37 CFR 41.37(c)). 37 CFR 41.37(d)< provides that if a brief is filed which does not comply with all the requirements of paragraph (c), the appellant will be notified of the reasons for noncompliance. Appellant will be given ~~**~~ 1 month or 30 days from the mailing of the notification of non-compliance, whichever is longer ~~**>~~to file an amended brief.< Extensions of time may be granted under 37 CFR 1.136(a) or 1.136(b). The ~~**>~~Office< may use the form paragraphs set forth below or form PTOL-462, ‘Notification of ~~**>~~Non-Compliant Appeal Brief (37 CFR 41.37)<’ to notify appellant that the appeal brief is defective. The appeal will be dismissed if the appellant does not timely file an amended brief, or files an amended brief which does not overcome all the reasons for noncompliance of which the appellant was notified.

Under 37 CFR ~~**>~~41.37(d)<, the appellant may file an amended brief to correct ~~**>~~the< deficiencies in the original brief. Moreover, if appellant disagrees with the ~~*~~ holding of noncompliance, a petition under 37 CFR 1.181 >or 41.3< may be filed. >Filing a petition will not toll the time period. Appellant must timely reply to the notice or the Office communication that requires an amended brief.

1215.04 [R-3] Dismissal of Appeal

If no brief is filed within the time prescribed by 37 CFR ~~**>~~41.37<, the appeal stands dismissed by operation of the rule. Form PTOL-461 ~~**~~ or form paragraph ~~**>~~12.117< notifying the appellant that the appeal stands dismissed is not an action in the case and does not start any period for reply. If no claims stand allowed, an application is considered as abandoned on the date the brief was due. If claims stand allowed in an application, the failure to file a brief and consequent dismissal of the appeal is to be treated as a withdrawal of the appeal and of any claim not standing allowed. The application should be passed to issue forthwith. Unless appellant specifically withdraws the appeal as to rejected claims, the appeal should not be dismissed until the extended period (5 months >of extension are available< under 37 CFR 1.136(a)) to file the brief has expired.

Applications having no allowed claims will be abandoned. Claims which are allowable except for their dependency from rejected claims will be treated as if they were rejected. The following examples illustrate the appropriate approach to be taken by the examiner in various situations:

- (A) Claim 1 is allowed; claims 2 and 3 are rejected. The examiner should cancel claims 2 and 3 and issue the application with claim 1 only.
- (B) Claims 1 - 3 are rejected. The examiner should hold the application abandoned.
- (C) Claim 1 is rejected and claim 2 is objected to as being allowable except for its dependency from claim 1. The examiner should hold the application abandoned.

(D) Claim 1 is rejected and claim 2 is objected to as being allowable except for its dependency from claim 1; independent claim 3 is allowed. The examiner should cancel claims 1 and 2 and issue the application with claim 3 only.

However, if formal matters remain to be attended to, the examiner should take appropriate action on such matters, setting a shortened period for reply, but the application or reexamination proceeding is to be considered closed to further prosecution except as to such matters. Form paragraph *> 12.109.01< may be used for this purpose.

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An appeal will also be dismissed if an applicant fails to timely and fully reply to a notice of noncompliance with 37 CFR *>41.37(d)<. See MPEP § *>1205.03< and 37 CFR *>41.37(d)<. As in examples (B)-(C) above, if no allowed claims remain in an application, the application is abandoned as of the date the reply to the notice was due (emphasis added).

Appellant argues that on "April 6, 2009, the patent office provided three new items that were wrong with the appeal brief. Improperly the patent office did not provide a new period for responding." However, a further review of the April 6, 2009 miscellaneous communication reveals that the appeal brief filed January 2, 2009 was defective for two reasons, 1) that it "does not contain a proper statement of the claims since the status of claim 28 is not identified" and 2) that it does not present arguments "under a separate heading for each ground of rejection on appeal."

Appellant is correct that the December 2, 2008 notification of non-compliant appeal brief does not address the issue of the status of claim 28 as being missing. However, in the first notification of non-compliant appeal brief mailed August 28, 2008, appellant was notified that "the brief does not contain the status of all the claims in the application," specifically, "claims 3, 8, 14, 16, 21, 22, 28-35-50 [sic] are not included in the status of claims section." Claim 28 is listed among the claims identified. Thus, the examiner did not err in not providing appellant with a new time period, since appellant had been previously notified that the status of claim 28 is required. Accordingly, Appellant's time period for response continues to run from the mailing date of the December 2, 2008 notification of non-compliant appeal brief.

In the petition, appellant contends that the Office improperly held the application abandoned by considering that the "applicant's resubmission of the appeal brief of April 9 09 is untimely." Appellant argues that while in the appeal brief dated April 9, 2009 "applicant did not pay for the extension fee, the appeal brief as filed provided a blanket charge authorization to deposit account number 501387." A review of the appeal brief submitted April 9, 2009 does show that on the bottom of page 18, appellant provided a general authorization "to apply any charges not covered, including any necessary extensions of time." The appeal brief filed April 9, 2009 is timely with a four month extension of time. Appellant's deposit account will be charged the fee of \$865 for a four month extension of time.

Appellant further asserts "the patent office held the application abandoned, stating that "applicants resubmission of the appeal brief of April 9 09 is untimely and remains noncompliant.'" Appellants further traverses the holding of the noncompliance, "since applicant believes that the appeal brief filed on April 9, 2009 was in fact timely, and did respond to each of those element." A review of the June 11, 2009 communication reveals that the examiner indicated that the April 9, 2009 appeal brief "remains defective because there are no heading for each of the grounds of rejection."

A thorough review of the appeal brief filed April 9, 2009 reveals that on page 9 of the appeal brief, there are five grounds of rejection. However, on pages 10 and 13 appellant only provides the heading "Rejections Under Section 112" and "Rejections Under 35 USC 103", respectively. As indicated above, 37 CFR 41.37(c)(1)(vii) and MPEP 1205.02 requires that "each ground of rejection must be treated under a separate heading." Since appellant did not provide each of the five grounds of rejection under separate headings, the appeal brief was properly held by the examiner to be non-compliant. Furthermore, the prosecution history shows that in the Notification of Non-Compliant Appeal Brief mailed December 2, 2008 and the miscellaneous communication mailed April 6, 2009, the examiner notified appellant that the brief did not present the arguments under a separate heading for each ground of rejection on appeal as is required by 37 CFR 41.37(c)(1)(vii). As indicated above, per MPEP 1215.04, the appeal will be dismissed if the appellant files an amended brief which does not overcome all the reasons for noncompliance of which the appellant was notified. If no allowed claims remain in an application, the application is abandoned as of the date the reply to the notice was due. Accordingly, the application was properly held abandoned by the examiner.

Accordingly, the application will be forwarded to the Supervisory Legal Instruments Examiner so that the fee of \$865 for a four month extension of time due with the filing of the April 9, 2009 appeal brief can be charged against appellant's deposit account number 501387.

As appellant has alternatively requested revival of unintentionally abandoned application under 37 CFR 1.137(b), the application will be forwarded to the Office of Petitions to render a decision on the request for revival.

Any inquiries regarding this decision should be directed to Teri P. Luu, Quality Assurance Specialist, at (571) 272-7045



Katherine Matecki, Director
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KM/tl: 12/9/09

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